

Serial No. 10/807,006

Applicant: Robert C. Berfield

Amendment Dated September 16, 2005

Reply to Office Action of July 28, 2005

Attorney's Case No. 1-771

Confirmation No. 2819

REMARKS/ARGUMENTS

Elections/Restrictions

Applicant acknowledges its prior election to Invention I. Claims 10-15 directed to Inventions II and III were previously canceled from the application.

Specification

In response to the noted informality, the third full paragraph of Page 10 of the specification has been corrected.

Section 112 Rejection

In response to the Section 112 rejection, "on the support" has been canceled from claim 1. Entry of the amendment and withdrawal of the rejection are solicited.

Section 103 Rejection

Claims 1-2, 5-6, 8, 16-17, 19-20 and 22 are rejected under Section 103 as being unpatentable over an asserted obvious combination of Dodd in view of Iversen. Applicant does not agree and requests reconsideration and withdrawal of the rejection in view of the following.

Primary reference Dodd discloses a circa-1941 container for vacuum cleaners. This container, shown at Figure 3, has a frame structure having a rectangular top with four corners. At each corner two spaced flat upright portions 19 and 22 are mounted on the outer end of a member 14. See Figure 4 and Page 1, column 2,

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lines 18-31.

"The flexible tube T of the cleaner may be mounted on the brackets 21, being clamped to these brackets by means of the upright portions 22 of these brackets and the upright portions 19 of the clamp members 17." (Page 2, column 1, lines 12-16)

The flexible tube T mounted on the brackets is shown in Figure 2. The tube is wound around the corners of the rectangular frame and positioned between the upright portions 19 and 22 at each corner of the frame.

The patent makes clear that the tube T is "clamped" between these brackets. At each corner a single length of tube T extends between the two brackets at the corner and is clamped between the brackets. Each flat bracket engages the opposite sides of a single length portion of the tube.

Dodd contains no disclosure of the structure of tube T. There is no disclosure of how the tube is wound around the frame and positioned between the four pairs of clamp members. Figure 2 shows the tube and bears circumferential lines indicating that the tube is generally cylindrical. There is NO teaching or suggestion in Dodd that tube T is corrugated. There is NO teaching of ribs which fit into tube valleys.

Further, there is no teaching or suggestion in Dodd that the tube shown in Figure 2 includes an elastically bowed portion. Clearly, bowed portions of tube T extend between adjacent pairs.

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There is no teaching or suggestion in the reference that these portions hold the portions of the tube against the outer clamp members 22. Dodd uses flat brackets to clamp single tube sections.

Applicant submits that a person of ordinary skill in the art viewing the teaching of Dodd would appreciate that tube T is a circa-1941 vacuum cleaner tube having a generally cylindrical and flaccid construction. There is no teaching that tube T is a corrugated hose as disclosed in the present application capable of being bent to form an elastically bowed portion which biases adjacent side sections against ribs to hold the hose in place.

Secondary reference Iversen discloses a vacuum hose holder with opposed rib pairs 48 shown in Figure 3. A single section of vacuum cleaner hose is positioned between the tapered rib pairs 146 to hold the hose in place. The patent teaches: "With this design, it is possible to place hose 114 therebetween [rib pairs 148] with a mere toss." (Column 3, lines 54-55)

Whether manually placed or tossed between rib pairs, gravity holds the hose in place. Note Figure 1. All holders disclosed in Iversen face upwardly to receive a hose moved downwardly in the holder so that once the hose is in the holder gravity holds the hose in place against rib pairs 148.

Iversen does not disclose elastically bowing a portion of a corrugated hose and using the bowed portion to seat side sections

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in ribs so that the ribs hold the hose in place.

Applicant traverses the Section 103 rejection based on alleged obvious combination of Dodd in view of Iversen because a prima facie case of obviousness has not been established. The Examiner bears the burden of establishing a prima facie case of obviousness based on the prior art. Prima facie obviousness can be established by objective teachings in the prior art and/or a showing that knowledge generally available to one of ordinary skill in the art would lead to a combination of the teachings of the references to meet the claims.

However, the requirement for establishing prima facie obviousness is that the prior art MUST teach all limitations of the claims or suggest limitations not found in the art and must contain a suggestion or incentive to combine the teachings.

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." (ACS Hosp. Systems, Inc. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984))

An obviousness rejection must be based on the teachings of the prior art. Hindsight is impermissible:

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"Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.' (In re Fritch, 23 USPQ2d 1780, 1782 (Fed. Cir. 1992)

In the present case, *prima facie* obviousness has not been established because neither Dodd nor Fritch disclose or suggest, singularly or in combination, applicant's invention. Neither reference teaches use of an elastically bowed portion of a corrugated hose to bias side sections of the hose against ribs to hold the hose in place. Both patents disclose vacuum cleaner hoses with bowed sections. Neither reference teaches an elastically bowed hose section can be used to hold the hose against ribs.

There is no teaching or suggestion in Dodd that the bowed sections of the disclosed tube T holds the tube against the outer most clamp member 22. Rather, single portions of tube T are held

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between opposed clamp members 19 and 22. There is no disclosure that tube T is corrugated. There is no teaching of engaging a corrugated hose against a rib to hold the hose in place.

Iversen discloses a vacuum cleaner hose 14 which is placed or tossed between two rib pairs 148. Gravity holds the hose in place.

In view of the failure of Dodd and Iversen disclosed elements of applicant's invention, a prima facie case of obviousness has not been established.

Further, there is no incentive or suggestion in Dodd or Iversen to combine the references as proposed by the Examiner. Both references teach positioning a single length of vacuum cleaner hose in a holder which engages the opposite sides of the single length of hose. Neither of the references teaches positioning side sections of a hose between ribs which engages opposite the side sections of the hose to hold the hose in place.

The deficiencies of the references indicates the rejection was made because of hindsight, that is, an improper reliance on applicant's own disclosure. Hindsight recombination of the references does not establish prima facie obviousness.

Reconsideration of the rejection and allowance of the claims is respectfully solicited.

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This amendment addresses all issues raised in the Office Action dated July 28, 2005 and is believed to place the application in condition for allowance. Such favorable action is solicited.

Respectfully submitted,

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